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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,471	12/15/2000	Peter M. Black	50740(3)	9663

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EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/738,471

Applicant(s)

BLACK ET AL.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to the social sciences, for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-10 recite only an abstract idea. The recited steps of claim 1 of merely conducting a statistical frequency analysis of the word occurrence in a document and preparing a list of products to be displayed does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to prepare a list of products that include certain keywords.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the system is for displaying products available for purchase to consumers who are displaying any document

on any computer device. Looking at the claim as a whole, nothing in the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claims 1-10 are useful because while claim 1 does not specifically include that the list is displayed it is clear from the specification that the list of products with the relevant keywords is displayed to consumers. The invention of claims 1-10 is concrete because repeatable results are obtained. However, the invention of claims 1-10 is not tangible because it consists solely of the manipulation of an abstract idea. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 112***

2. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite because it is not clear if the applicant is claiming a method or an apparatus or an apparatus that performs a method. The preamble of these claims calls for a system, which suggests an apparatus. However, the body of these claims includes only method steps, but they are not steps of using the system of the preamble. Therefore, there is no agreement between the preamble and the body.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 6, 8, 9, 11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Donner et al.

Donner et al disclose an apparatus and method for retrieving and grouping images representing text files by conducting a word frequency

analysis of a reference document to determine keywords and prepare a list of documents relevant to the keywords, see especially col. 7, line 15 to col. 8, line 40. Re claim 4, Donner et al disclose that a user may select keywords, see col. 5, lines 33-37. Re claim 8, Donner et al disclose a Boolean query in col. 5, line 65 to col. 6, line 13.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al. Donner et al disclose all the features of the applicants' claimed invention except the manual selection of products for display. Merely calling for the manual performance of a previously automated process involves only a notorious expedient in any art.

8. Claims 5, 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al in view of Conklin et al. Donner et al disclose all the features of the applicants' claimed invention except the metatags in the documents. Conklin et al disclose in col. 29, lines 4-20 inserting metatags into documents to give higher priority to keywords in the documents. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Conklin et al to provide the documents of Donner et al with metatagging to give higher priority to certain keywords.

9. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al in view of Kanaegami et al. Donner et



al disclose all the features of the applicants' claimed invention except associating the keywords with their synonyms. Kanaegami et al disclose a text search system that associates keywords with their synonyms to improve the search results, see col. 1, lines 26-45. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Kanaegami et al to associate the keywords of Donner et al with their synonyms to improve the search results.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donner et al in view of Arnold et al. Donner et al disclose all the features of the applicants' claimed invention except including links to a sale site for the products. Arnold et al disclose web pages that include links to a sale site of products to allow users to purchase the products. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Arnold et al to provide the search results of Donner et al with links to sale sites of the products to allow users to purchase the products.

***Drawings***

11. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the steps of the claims must be shown, for example in a flow diagram, or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

The objection to the drawings will not be held in abeyance.

12. Figure 1-5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J.

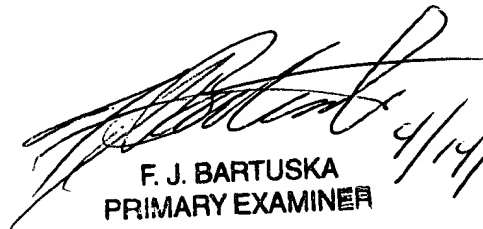
BARTUSKA whose telephone number is 703-308-1111. The examiner

can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI or the currently acting supervisor, can be reached on 703-308-1113. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

fjb  
April 14, 2003

  
F. J. BARTUSKA  
PRIMARY EXAMINER 4/14/03